

**REMARKS**

In the Office Action<sup>1</sup>, the Examiner took the following actions:

(i) rejected claims 25 and 28 under 35 U.S.C. § 101 as being directed to non-statutory matter; and

(ii) rejected claims 1-8, 10-19, 21-25, 28, 29, 31, and 33-35 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,493,396 to Alcorn et al. ("*Alcorn*") in view of U.S. Patent No. 7,548,957 to Wichmann et al. ("*Wichmann*").

By this Amendment, Applicant has amended claims 1, 14, 25, 28, and 29.

Applicant notes that support for the amended language of claims 1, 14, 25, and 29 can be found at least in paragraphs 28, 33, and 34 and in Figure 1 of the published version of the application, US 2004/0083265. No prohibited new matter has been added.

Claims 9, 20, 26, 27, 30, and 32 were previously cancelled. Accordingly, claims 1-8, 10-19, 21-25, 28, 29, 31, and 33-35 remain under examination.

Applicant respectfully traverses the rejections and submits that the pending claims are in condition for allowance, for at least the reasons set forth below.

**I. Rejection of Claims 25 and 28 under 35 U.S.C. § 101**

Applicant respectfully traverses the rejection of claims 25 and 28 under 35 U.S.C. § 101. In the Office Action, the Examiner contends that "Applicant has not defined a computer-readable medium in the specification" and that "Applicant's definition of a machine-readable medium is not controlling on a computer-readable medium." See

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<sup>1</sup> The Office Action may contain a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization of the Office Action.

Office Action, p. 5. The Examiner further contends that “[i]f Applicant’s definition of a machine-readable medium is controlling on a computer-readable medium, then Applicant has defined a machine-readable medium to encompass a machine-readable signal, which does not fall within the four statutory categories of invention.” See Office Action, p. 5. The Examiner also contends that “[i]f Applicant’s definition of machine-readable medium is not applicable to a computer-readable medium, then Applicant has failed to define a computer-readable medium in the specification and ... the computer-readable medium should be treated as encompassing transitory propagating signals, which do not fall within the four statutory categories of invention.” See Office Action, p. 5. The Examiner notes that the rejection can be overcome by amending to add the claim limitation of “non-transitory.” See Office Action, p. 5. While not necessarily agreeing with the Examiner’s assertions, Applicant has amended claims 25 and 28 for even further clarity, reciting “non-transitory computer-readable medium.” As such, Applicant respectfully requests withdrawal of the rejection of claims 25 and 28 under 35 U.S.C. § 101.

**II. Rejection of Claims 1-8, 10-19, 21-25, 28, 29, 31, and 33-35 under 35 U.S.C. § 103(a)**

Applicant respectfully traverses the rejection of claims 1-8, 10-19, 21-25, 28, 29, 31, and 33-35 under 35 U.S.C. § 103(a) as being unpatentable over *Alcorn* in view of *Wichmann*. A *prima facie* case of obviousness has not been established.

"[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in Graham v. John Deere Co., 383 U.S. 1, 148 U.S.P.Q 459 (1966)

. . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art."

M.P.E.P. § 2141(11). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(111). Here, no *prima facie* case of obviousness has been established for at least the reason that the scope and content of the prior art has not been properly determined and the differences between the prior art and the claimed combinations have not been properly ascertained.

Claim 1 calls for a combination of elements, including, *inter alia*:

providing a member of a specific one of the defined communities with access to the respective one of the collaborative conversation channels through a user interface, with each one of the collaborative conversation channels having an associated set of message types that is based on a topic of the specific one of the defined communities and a role of the member within the specific one of the defined communities, the associated set of message types corresponding to a plurality of different message templates; and

presenting one of the message templates that corresponds to the selected message type.

(emphasis added).

*Alcorn* relates to "[a] system and methods for implementing education online by providing institutions with the means for allowing the creation of courses to be taken by students online, the courses including assignments, announcements, course materials, [and] chat ... all of which are available to the students over a network." See *Alcorn*, Abstract. In the Office Action, the Examiner asserts that the "list of threads in the

discussion board” in Figure 13 of *Alcorn* teaches an “associated set of message types” as recited in claim 1. See Office Action, pp. 6, 7. While not necessarily agreeing with the Examiner, Applicant has amended the claims to further clarify “the associated set of message types corresponding to a plurality of different message templates” and that the method includes “presenting one of the message templates that corresponds to the selected message type.” *Alcorn* does not teach or suggest “the associated set of message types corresponding to a plurality of different message templates” and that the method includes “presenting one of the message templates that corresponds to the selected message type,” as recited in amended independent claim 1. *Wichmann* also does not teach or suggest the above-discussed elements of independent claim 1.

*Wichmann* is directed towards “[d]iscussion forum portlets, notice board portlets, and memo pad portlets [that] may be used to provide discussion forum functionality, notice board functionality, and memo pad functionality.” See *Wichmann*, Abstract. With respect to claim 6, the Examiner contends that Figure 8 teaches that “the set of message types includes predefined message templates,” because “Figure 8 is a message template for messages in [a] discussion board.” See Office Action, p. 9. While not necessarily agreeing with the Examiner, *Wichmann* nevertheless fails to teach or suggest “the associated set of message types corresponding to a plurality of different message templates” and that the method includes “presenting one of the message templates that corresponds to the selected message type,” as recited in amended independent claim 1 (emphasis added).

Accordingly, the scope and content of the prior art have not been properly determined and the differences between the prior art and the combinations of claim 1 have not been properly ascertained. Thus, no *prima facie* case of obviousness has been established for claim 1. The rejection of claim 1 under 35 U.S.C. § 103(a) is thus improper and should be withdrawn.

Amended independent claims 14, 25, and 29, although different in scope, recite features similar to claim 1 and also are not obvious over *Alcorn* in view of *Wichmann* for reasons similar to those presented above for claim 1. The rejection of claims 14, 25, and 29 under 35 U.S.C. § 103(a) is thus improper and should be withdrawn.

Dependent claims 2-8, 10-13, 15-19, 21-24, 28, 31, and 33-35 are also not rendered obvious by the prior art of record, at least because they depend from allowable base claims, and further in view of the additional features recited by these claims. Thus, the rejection of claims 2-8, 10-13, 15-19, 21-24, 28, 31, and 33-35 under 35 U.S.C. § 103(a) is thus improper and should be withdrawn.

### **CONCLUSION**

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

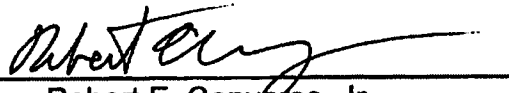
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Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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